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EXAMINER

DASS, HARISH T

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/054,689	Applicant(s) WEBER, HARRY V.	
	Examiner HARISH T. DASS	Art Unit 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-13, 15, 17, 19-25, 56, 57 and 59-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-13, 15, 17, 19-25, 56, 57 and 59-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to Applicant's communication of 2/10/2010.

1. Declaration under 37 CFR 1.131 is accepted and entered (see previous actions).

2. Status of claims:

Claims 1-10, 14, 16, 18, 26-55, 58 are canceled.

Claims 11-13, 15, 17, 19-25, 56-57, 59-66 are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful **process, machine, manufacture, or composition of matter**, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-13, 15, 17, 19-25, 56-57, 59-66 remains rejected under 35 U.S.C. 101 because: claims 11-13, 15, 17, 19-25, 56-57, 59-66 are directed to non-statutory subject matter.

In case of claim 11 and its dependent claims (12-13, 15, 17, 19-25, 56-57, 59), and scope of the claim "**web-based application** *for providing a multilevel financial aid system featuring integrated and automated on-line financial aid features specific to a given educational institution to a user*" is unpatentable as directed to nonstatutory subject matter under 35 U.S.C. §101, since the claimed invention (**web-based application**) does not fall within one of the four statutory categories process, machine, manufacture, or composition of matter, therefore based on the analysis of **web-based application** (claim 11) limitations the claim is directed to Computer per se, because;

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mental processes standing alone are not patentable, even if they have practical applications (MPEP 2106).

The language of claim 11 does not limit the claim to a particular structure, because, the claim at issue (claim 11)

does not use any machine such as: computer, server, etc.

or

does not describe process of manufacture or process for alteration of composition of matter, and

every claimed limitation is directed to providing a service (for example: collection service, estimation service, link service, a service for, etc. per se does not appear to be a process, machine, manufacture, or composition of matter - see *In re Nuijten*) from a web page without providing a particular structure. For example, if the scope of the claim is for:

process claim see *In re Bilski*,

product claims, the claim limitations will define discrete physical structures or materials.

The claim limitation analysis of claim 11 clearly does not identifying whether the claim is directed to a process or product neither the claim is for non-transitory machine-readable medium (statutory categories - process, machine, manufacture, or composition of matter).

The preamble states "A web-based application *for providing a multilevel financial aid system featuring integrated and automated on-line financial aid features*

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specific to a given educational institution to a user, wherein said web-based application comprises:” which failed to claim either a process (method), system or non-transitory machine-readable medium.

The claimed limitations are list of number of services that can be provided by an entity or group of service providers (i.e., public library, colleges, etc). The limitation failed to include process tied to a machine or physical structure. Therefore it is not clear what the invention encompass. Therefore the Examiner’s conclusion is in absence of claimed structure, the claims are directed to Computer per se. The claim is Computer per se because the idea may be compilation of written code lines on paper or computer document and may be implemented by an entity.

In case of claim 60 and its dependent claim (61-66), “**web-based application**, *for providing a multi-level financial aid system featuring integrated and automated on-line financial aid features specific to a given educational institution*” is unpatentable as directed to nonstatutory subject matter under 35 U.S.C. §101, since the claimed invention (**web-based application**) does not fall within one of the four statutory categories (**process, machine, manufacture, or composition of matter**), therefore the **web-based application** of claim 60 is directed to Computer per se [see above]. Since mental processes standing alone are not patentable, even if they have practical applications.

The language of claim 60, does not use a machine or does not describe process of manufacture or process for alteration of composition of matter **neither** the claim is for **non-transitory machine-readable medium**. Every limitation is directed to providing a

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service, and clearly does not identifying whether the claim is directed to a process or product, or **non-transitory machine-readable medium**, therefore the Examiner's conclusion is in absence of claimed structure, the claims are directed to Computer per se. [see above].

Note: In order to comply with Subject matter Eligibility under USC 101, and advance the prosecution, Applicant should clear claim one of the four statutory category (**process, machine, manufacture, or composition of matter**) either a process or product and include (for process/method) the machine-or-transformation per Bilski and for product (system) include the structure (see MPEP 2106).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-13, 15, 17, 19-25, 56-57, 59-66 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 and claim 60, beside being a descriptive material (computer per se) by listing number of services, have missing steps for example, "a service for comparing", where is the result of comparing and where the result is used? Similarly for other services with intended use "for" clauses, where the claims do not positively indicate the next step which uses the result of the previous service (do not claim any following

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functionality which uses the information of previous limitation). The claimed language has missing step which create gap in the process of the invention for concrete and tangible result.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

Claims 11-13, 15, 17, 19-25, 56-57, 59-66 remain rejected under 35 U.S.C. 103(a) as being unpatentable over "Financial Aid Prospecting - ONLINE: The Internet Is Loaded With Valuable Financial Aid Information, but Few Campus Web Sites Are Designed to Help Them Find It"; Terrell, Kenneth. Black Issues in Higher Education. Reston: Oct 28, 1999. Vol. 16, Iss. 18; pg. 38 (hereinafter Terrell) in view of Ireland et al. (hereinafter Ireland – US 7,062,462) and Norris (US 5,870,721) and Applicant's Admitted Prior Art (AAPA).

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Re. Claim 11, Terrell discloses applying for financial student aid online using Internet websites for higher education such as Sallie Mae and linking of financial aid web page to online FAFSA to expedite the application process;

a first information collection service for obtaining requested personal and financial information about a given student [see NPL 7 pages], Internet FTP for transferring files, a federal link service (see web page link to www.fafsa.ed.gov).

Terrell does implicitly disclose the back-end computer processing of the financial aid application process maintained by the US Department of Education which interacts with applicant instantaneously to expedite the process and avoid delays which may effect the amount of aid student receives.

Terrell does not explicitly disclose

a financial aid estimation service for evaluating the information obtained via said first information collection service and generating a predicted amount of monetary aid that may be available for the student to use for education-related expenses at a given educational institution;

receiving an electronic copy of an Institutional Student Information Report (ISIR) document for the given student;

a service for comparing information obtained via said first information collection service and the given student's ISIR document;

a service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution; and

a service for providing an award notice to the given student based on the determination of authorized financial aid eligibility

However, Student loan/financial aid process, FAFSA and Institutional Student Information Report (ISIR) are well known elements and ISIR is send/received by schools electronically as well as paper copy. Further, are known means of file transfer (receiving/transmitting) using Internet FTP and computers, where FTP uses the address (link) of the web-server to receive/transmit files (documents, reports, etc), batch programming and telnet for automation of computer processing and viewing documents.

Ireland discloses online higher education financing system and method and online websites which provide calculating functions, and back-end computer (Network Server – see Fig. 1; col. 2 lines 32-35 (Sallie Mae which provides ...), col. 5 lines 60~). Further, **Ireland** discloses a financial aid estimation service; generating a predicted amount of monetary aid that may be available for the student to use for education-related expenses at a given educational institution; and a service for providing an award notice to the given student based on the determination of authorized financial aid eligibility [Figures 1-3; col. 15 lines 4-26; col. 7 lines 6-31, additionally see figures which have more information]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Terrell and include a financial aid estimation service; generating a predicted amount of monetary aid that may be available for the student to use for education-related expenses at a given educational institution; and a service for providing an award notice to the given student based on the determination of authorized financial aid eligibility, as disclosed by Ireland,

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to provide an online student financial aid resource which allows the student/parent to calculate the estimated cost of educational and available financial aid require for student to attend an educational institution.

AAPA discloses evaluating the information obtained via said first information collection service; a service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution [page 1-3 (background)]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Terrell and Ireland and include evaluating the information obtained via said first information collection service; a service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution, as disclosed by AAPA, to provide a web-based student financial aid delivery and management system where the entire financial aid process is interactive and online for instantaneous Plus loan pre-approval, calculating college cost and post graduation budget planning.

Norris (analogous art) discloses a lending system, receiving applicant's information of a loan by electronic communication and automatic processing of loan, and

receiving an electronic copy of loan document of borrower (analogous to an Institutional Student Information Report (ISIR) document for the given student); a service for comparing information obtained via said first information collection service (database - analogous service) and the given borrowers loan application/document (analogous to student's ISIR document) [See entire document particularly, abstract;

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Figure 1; col. 2 lines 17-34; col. 7 lines 55-65; claim 1 - comparing two documents for verification]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Terrell, Ireland, and AAPA and include verification process, as disclosed by Norris, to provide a borrower's data matching system to verify the borrower's identity against third party database for processing/approval of loan. Since the claimed invention is merely a combination of old elements, and in the combination each element merely would perform the same function as it did separately, and one of ordinary skill in the art would recognized that the results of the combination were predictable.

Re. Claim 12, Terrell discloses wherein said web-based application further comprises a registration service for applying for and receiving a user identification element, and whereby said user identification element is utilized for obtaining future access to said web-based application, including various features and services thereof [see enrollment and online application].

Re. Claim 13, Terrell discloses a second information collection service, for obtaining additionally requested information related to personal demographics, financial matters, and educational endeavors of a given student [see fill up, inherent in Terrell].

Re. Claim 13, Terrell discloses a federal link service (www.fafsa.ed.gov) for electronically relaying federal aid eligibility information between the web based

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application and processing systems of selected government agencies, wherein one of said selected government agencies corresponds to the United States Department of Education.

Re. Claim 17, 19-25, and 55-59 Terrell discloses federal aid link service provides links at the web-based system for directly connecting a user to a FAFSA on-line web-based location and to an Ins on-line web-based location. Ireland discloses selected information obtained via said student file establishment service comprises information obtained via said first information collection service and said second information collection service, federal aid eligibility information obtained via said federal link service, and enrollment information about a given student obtained from an educational institution [col. 7 lines 10-30, 51-65; see database Figure 1], a file processing service for reviewing information collected about a given student via said file establishment service and for determining eligibility for various types of financial aid that are potentially available for a student, a loan application service for electronically relaying master promissory note (MPN) documentation between a system user and a loan guarantor, wherein said loan guarantor is characterized as one who provides monetary assistance to a student for education-related expenses, a reporting system service available to a user of the web-based application, for obtaining updated information about the financial aid system and progress involved with said file processing service thereof, a communications service for automatically generating and sending an electronic communication from a student or educational institution to a student financial aid processor, and wherein the user

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identification element received via said registration service is utilized as an electronic signature for affirming various statements presented in accordance with the multi-level financial aid system [see entire document particularly; col. 3 line 51 to col. 4 line 4; col. 6 line 55 to col. 7 line 65; col. 22 lines 7 to col. 23 line 28; claims 1-2]. Additionally, a service for obtaining a copy of an Institutional Student Information Report (ISIR) document for the given student, a service for obtaining enrollment verification information for the given student from one or more specified educational institutions, and wherein selected portions of the information obtained from said first information collection service, said service for obtaining a copy of an ISIR document and said service for obtaining enrollment verification information are reviewed by a financial aid processing center, a service for comparing information obtained via said first information collection service and the given student's ISIR document; a service for determining what financial aid the given student is eligible for; and a service for providing an award notice to the given student based on the determination of financial aid eligibility, and a service for determining whether the given student's corresponding information complies with federal regulatory standards for financial aid eligibility are inherent in Terrell, Ireland and AAPA. Further, an integrated feature that automatically updates the web-based application, particularly updating information related to received documents and progress of financial aid processing is well-known specially software companies website such as Microsoft explores which automatically updates the website. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Terrell, AAPA and

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Norris and include the disclosure of Ireland, as disclosed above, to provide a method and apparatus for students and parents with education financing information, online filing at reduce the costs for a school to transmit financial aid award packages to potential students and help student to apply timely for student aid and get the result/decision quickly using their computer. Since the claimed invention is merely a combination of old elements, and in the combination each element merely would perform the same function as it did separately, and one of ordinary skill in the art would recognized that the results of the combination were predictable.

Claims 60-66 are rejected with same rational as claim 11 and associated dependent claims (Terrell in view of Ireland, AAPA and Norris).

Response to Arguments

5. Applicant's arguments filed 2/10/2010 have been fully considered but they are not persuasive. See the rejection above, responses are included in rejection(s) in response to the claim(s).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HARISH T. DASS whose telephone number is (571)272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kyle Charles can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harish T Dass/
Primary Examiner, Art Unit 3695

Thursday, May 06, 2010